

## REMARKS

- Claims 1-4, 6-10, 12-16, 18 – 24 and 31-34 are pending.
- All claims stand rejected.

### I. Objection – Drawings

The drawings have been objected to under 37 CFR 1.83(a) as not showing the claimed feature of “the random outcome is statistically independent of said hand of blackjack prior to said push.” Office Action mailed July 13, 2005 (“Current Office Action” herein, page 2). Applicants respectfully disagree that the drawings as filed do not show this feature. FIG. 3, for example, illustrates that a random number that is not based on any other outcome or random number may be generated and used to determine a winning amount for a hand that has resulted in a push. As described in the specification “The table includes entries identifying one or more random outcomes. In particular, the winning amount database 300 shown in FIG. 3 illustrates random outputs 302 generated by a five-bit random result device 240 (*e.g.*, representing the numbers 0 through 31).” Specification, page 7, lines 3 – 6.

However, to expedite allowance of the pending claims, Applicants have added FIG. 6 herein, depicting a flowchart illustrating a method that explicitly recites the specified feature. The Specification has been amended to refer to the new FIG. 6. No new matter has been added.

## **II. Claim Rejections – Section 101**

Claims **1 – 4, 6 – 10, 12 – 16, 18 – 24, 31 – 32 and 34** stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Current Office Action, pages 3 – 4. Specifically, the Examiner has asserted that claims **1, 3 – 4, 6 – 10, 12 – 16, 17 – 24, 31 – 32 and 34** “do not constitute a concrete result. Although a determination is made regarding the hand or plurality of hands blackjack, the result is never functionally used or displayed.” Current Office Action, page 3.

Regarding claim **2**, the Examiner has asserted that this claim “is concrete because the player is receiving a payment of a winning amount based on the wager amount.” Current Office Action, page 3. The Examiner has also asserted that claim **2** “provides a useful result.” Current Office Action, page 3. However, claim **2** is rejected under 35 U.S.C. §101 so Applicants are confused as to the grounds for the rejection of claim **2**. Applicants can only assume that the Examiner meant to reject this claim on the grounds that the result is not “tangible,” as this is the only part of the “useful, concrete and tangible” result test relied upon by the Examiner as the basis for the §101 rejection.

Regarding claims **1 – 4, 6 – 10, 12 – 16, 17 – 24, 31 – 32 and 34**, Applicants respectfully traverse the §101 rejection of these claims on the grounds that the claims do provide a useful, concrete and tangible result. Each of these claims recites generally (i) that a random outcome is received or determined and further (ii) that it is determined, based on the random outcome, if the player has won the hand of blackjack or other card game. These features render the claims statutory for much the same reason the

"final share price" of the claims in State Street Bank rendered the claims statutory:

“Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘*a useful, concrete and tangible result*’--*a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.*” State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d at 1373 (emphasis added).

Using similar reasoning, the feature of determining or receiving the random outcome alone is sufficient to render the claims statutory and as producing a useful, concrete and tangible result. As the “final share price” in State Street was a price relied upon by regulatory authorities and in subsequent trades, the random outcome of the pending claims is likewise accepted and relied upon by players and dealers as determinative of who wins a push in blackjack or another card game - it is something which is used to determine whether the player has won the hand that would otherwise have resulted in a push. It is noteworthy that neither State Street nor any other case law requires a claim to actually recite something being done with the useful, concrete and tangible result – in the claims of State Street that were determined to produce a useful, concrete and tangible result, the final share price is determined but the independent claims do not recite anything in particular being done with or based on the determined final share price. As the Federal Circuit explained, it is sufficient that the price may be

accepted and relied upon by an entity for some purpose, even when a step illustrating such reliance is not explicitly recited in the claims. In the presently rejected claims, the determined random outcome is accepted and relied upon by the player and dealer and is thus a useful, concrete and tangible result.

Further, as explained above, claims **1 – 4, 6 – 10, 12 – 16, 17 – 24, 31 – 32 and 34** are further statutory because they go being the requirements of State Street and do in fact recite an additional step in which the random outcome that is a useful, concrete and tangible result is used. The claims recite generally determining, based on the random outcome, if a player has won the hand of blackjack or other card game. Applicants respectfully submit that determining if a player has won the hand of blackjack or other card game is a useful, concrete and tangible result.

### **III. Claim Rejections – Section 112**

Claims **1 – 4, 6 – 10, 12 – 16 and 18 – 24** stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Current Office Action, page 4. Specifically, the Examiner has asserted that “the language of ‘generating an additional random outcome’ is vague and indefinite because an initial random outcome or a first random outcome must take place before a second or additional random outcome occurs. As more cards are dealt from a deck the deck becomes more deterministic and less random. Therefore, the limitation reciting the generation of an additional random outcome from a deck that is becoming more deterministic causes confusion about the claim and renders the claim indefinite.” Current Office Action, page 4.

First, Applicants respectfully point out that none of the claims rejected under §112, second paragraph, recite that the additional random outcome is “from a deck that is becoming more deterministic.” There is absolutely nothing in the claims to even imply, for example, that the additional random outcome comprises cards dealt from the same deck as the cards for the hand(s) that resulted in the push. In fact, the claims recite explicitly that the additional random outcome “is statistically independent of said hand of blackjack played prior to said push.” As explained in the specification, the additional random outcome may be a result, for example, of a dealer device, a toss of a coin, a roll of a pair of dice, a spin of a roulette-style wheel, a player device, or a controller that includes a random result device. Specification: page 4, lines 9 – 12; page 5, lines 14 – 18; page 5, line 32 – page 6, line 2; page 9, lines 20 – 25. In particular, the specification describes that the additional random outcome may be a result of obtaining a card from a separate deck of playing cards. Specification, page 9, line 30.

Second, as Applicants argued on page 8 of the Response to the Office Action mailed January 25, 2005, “the claim language, *generating an additional random outcome*, is neither vague nor indefinite as an initial random outcome has been generated by *dealing a first set of accumulated cards to a player, and dealing a second set of accumulated cards to a dealer*.” However, solely to expedite allowance of the pending claims and not for any reason related to patentability, Applicants have amended claim 1 (and thus claims 2 – 4, 6 – 10, 12 – 16 and 18 – 24 by virtue of these claims being dependent from claim 1) herein to explicitly recite that “the dealing of the first set of accumulated cards and the dealing of the second set of accumulated cards compris[es] a first random outcome.” Applicants believe

this amendment to be sufficient to overcome the Examiner's concerns regarding the claims with respect to Section 112, second paragraph.

#### **IV. Claim Rejections – Section 103**

Claims **1 – 4, 6 – 10, 12 – 16 and 18 – 24** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,803,460 to Hesse ("Hesse" herein) in view of U.S. Patent No. 5,746,432 to Feola ("Feola" herein).

Claims **31 – 32** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hesse in view of Feola and further in view of U.S. Patent No. 5,954,335 to Moody ("Moody" herein).

**CONCLUSION**

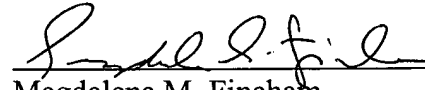
It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at [jskinder@walkerdigital.com](mailto:jskinder@walkerdigital.com).

Respectfully submitted,

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